REMARKS

Claims 1-12 are all the claims pending in the application.

As a preliminary matter, the specification is objected to as failing to provide support for the intersection angle between the crown portion and the side portion being larger than 90 degree, as recited in claims 1 and 11. Applicant submits that lines 15-18 on page 5 of the specification provide support for the claimed intersection angle and requests the Examiner to withdraw the objection of claims 1 and 11.

Claims 1-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchiya *et al.* (U.S. Patent No. 5,346,217; hereinafter "Tsuchiya") in view of Motomiya (U.S. Patent No. 4,438,931; hereinafter "Motomiya"), Hoshi (U.S. Patent No. 5,205,560; hereinafter "Hoshi"), Tsuchida (U.S. Patent No. 5,255,913; hereinafter "Tsuchida"), Kusumoto (U.S. Patent No. 6,634,958; hereinafter "Kusumoto") and Murphy (U.S. Patent No. 6,332,847; hereinafter "Murphy"). Claims 1-7 and 10-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/188,043 in view of Kusumoto and Murphy. Applicant submits the following in traversal.

Rejection of Claims 1-12 under §103(a) over Tsuchiya in view of Motomiya, Hoshi, Tsuchida, Kusumoto and Murphy

In the Office Action, the Examiner argues that claim 1 is obvious in view of the combination of Tsuchiya, Motomiya, Hoshi, Tsuchida, Kusumoto and Murphy. Specifically, the Examiner argues that Kusumoto and Murphy teach or suggest the newly added feature of claim 1

regarding a golf club head wherein an intersection angle between the crown portion and the side portion is larger than 90 degrees.

Applicant submits that claim 1 is patentable because prima facie obviousness has not been established. For example, the Examiner has not established how one skilled in the art would incorporate the teachings of Kusumoto with Murphy regarding the claimed intersection angle being larger than 90 degrees, into the golf club head of Tsuchiya as modified by Motomiya, Hoshi and Tsuchida. The Board of Patent Appeals and Interferences has held that:

> [p]resuming arguendo that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added).

Here, there is nothing in Kusumoto and Murphy that would expressly or impliedly teach or suggest the claimed combination. Additionally, the Office Action presents no line of reasoning as to why the artisan would have further modified the golf club head of Tsuchiya as

modified by Motomiya, Hoshi and Tsuchida, to incorporate the claimed intersection angle and render claim 1 obvious.

Claims 2-6, which depend from claim 1, are patentable for at least the reasons submitted for claim 1.

For reasons similar to those submitted for claim 1, claim 7 is patentable. Claims 8-12, which depend from claim 7, are patentable for at least the reasons submitted for claim 7.

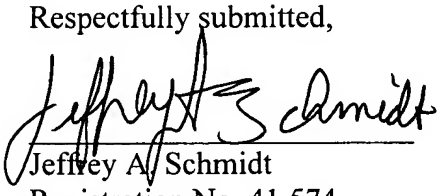
Provisional Rejection of Claims 1-7 and 10-12 on the ground of nonstatutory obviousness-type double patenting over claims 1-24 of copending Application No. 10/188,043 in view of Kusumoto and Murphy

Applicant submits herewith a Terminal Disclaimer to overcome the rejection of claims 1-7 and 10-12 on the ground of nonstatutory obviousness-type double patenting.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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